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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,588	05/15/2006	Josef Schmidt	12604/23	8455
26646 7590 02/09/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
HO, HA DINH				
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02/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/577,588

Applicant(s)

SCHMIDT ET AL.

Examiner

HA D. HO

Art Unit

3655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-105 is/are pending in the application.
- 4a) Of the above claim(s) 103-105 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51-60, 63-66, 68-71, 74, 75, 77-83, 86-91, 97 and 98 is/are allowed.
- 6) ☒ Claim(s) 44-50, 61, 62, 67, 72, 73, 76, 84, 85, 92-96 and 99-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/3/06, 2/12/07 & 5/23/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is the first Office Action on the merits of Application No. 10/577,588 filed on 05/15/06. Claims 44-105 are currently pending.

Election/Restrictions

2. Applicant's election with traverse of the invention I, claims 44-102 in the reply filed on 11/05/08 is acknowledged. The traversal is on the ground(s) that the present application is the U.S. national phase of international application PCT/EP2004/012800 and the unity of invention analysis is appropriate when determining the need for restriction in the application. This is found persuasive and the Restriction Requirement mailed 10/06/08 is hereby withdrawn.

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

4. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- Group I, claim(s) 44-102, drawn to a compact drive or a gear stage.
- Group II, claim(s) 103-105, drawn to a method for manufacturing a drive unit.

5. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

- There is no common special technical feature in the inventions of groups I and II, and
- The claimed features recited in both Groups I and II (see claims 47 and 103), i.e., “a central housing part” and “a stator of the electric motor detachably connecting to the central housing part”, are not considered as inventive features since a drive unit having a stator of an electric motor detachably connected to a central housing part is old and well known in the art. For example, the reference US 4,838,106 to Adams shows a drive unit (see Fig. 4) having a stator 24 of an electric motor 23 detachably connected to a central housing part 10 via bolts 26.

6. A telephone call was made to Mr. Ulrich on 01/29/09 to request an oral election to the above restriction requirement, but did not result in an election being made. Since Applicant's election with traverse of the invention I, claims 44-102 is filed on 11/05/08, Examiner assumes a provisional election to this Restriction Requirement would be made with traverse to prosecute the invention of Group I, claims 44-102. Affirmation of this election must be made by applicant in replying to this Office action. Claims 103-105 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 61, 62, 67, 72, 73, 76, 84, 85, 92-96 and 100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- The following limitations constitute a double inclusion because they were previously recited:
 - “an electronics compartment” in claim 61, line 3,
 - “an electronics compartment” in claim 62, line 2,
 - “an output shaft” in claim 67, line 2,
 - “an output shaft” in claim 76, lines 2-3, and
 - “a pinion” in claim 100, line 3.
- In claims 72 and 73, line 2, the recitation “the rest” is unclear of its reference.
- The following limitations lack antecedent basis:
 - “the sensors” in claim 84, line 3 (note only one sensor is recited in line 2),
 - “the rotor” in claim 85, line 2,
 - “the central housing part” in claim 92, line 3,
 - “the gear region” in claim 93, line 2,
 - “the stator windings” in claim 95, line 2,
 - “the stator windings” in claim 96, line 2,

- In claim 94, line 2, the additional of the word “type” to an otherwise definite expression extend the scope of the expression in the claims so as to render the claims indefinite. Ex parte Copenhaver, 109 USPQ 118 (Bd. App. 1955).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Heun et al (US 5,632,469).

Heun et al shows a compact drive (see Fig. 2) comprising at least three drive components (i.e., 13, 14; 8a and 17a); a central housing part (10), each drive component surrounded by the central housing part; and at least one housing cover (10a) of the respective drive component (13, 14) to form a specific housing.

As to claim 45, wherein the drive components include at least one of an electric motor 2, a gear unit 9 and an electronic circuit (13, 14).

As to claim 46, wherein the electronic circuit includes a frequency converter 14.

12. Claims 47, 48 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (US 4,838,106).

Adams shows a compact drive (see Fig. 4) comprising at least three drive components (23, 12, 11) including an electric motor 23; and a central housing part 10, a stator 24 of the electric motor detachably connected to the central housing part by a clamping joint 26, wherein the drive components include at least a gear unit (11, 12).

13. Claims 99-102 are rejected under 35 U.S.C. 102(b) as being anticipated by Depietri (US 5,634,374).

Depietri shows an axially offset, right-angle gear stage for a compact drive (see Fig. 2), comprising: a central housing part 2, each drive component (e.g., 23) surrounded by the central housing part and at least one housing cover (6 or 14) of a respective drive component (a gear) to form a specific housing.

As to claim 100, wherein the right-angle gear stage includes a wheel 26 and a pinion 25 engaging with the wheel, at least one of (a) the wheel including gear teeth on a front side and (b) the pinion 25 having a cylindrical contour at an outer periphery.

As to claim 101, wherein the gear stage is arranged as spiroid gear stage.

As to claim 102, wherein the gear stage is arranged as a spiroid gear stage in which a pinion axis does not intersect a wheel axis and is oriented perpendicularly to it, an axial offset less than a pitch-circle radius of gear teeth of the wheel (see Fig. 2).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heun et al (US 5,632,469) in view of Adams (US 4,838,106).

Heun et al shows a compact drive (see Fig. 1) comprising at least three drive components (2, 14, 9) including an electric motor 2; and a central housing part 2, a stator (the rotor is arranged about the rotor mounted on the motor shaft), and an electronic circuit including a frequency converter 14.

Heun et al does not show the stator of the electric motor 2 detachably connected to the central housing part 2.

Adams shows a compact drive, wherein the stator 24 of the electric motor 23 is detachably connected to the central housing part 10 by clamping joint 26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compact drive of Heun et al to have the stator of the electric motor detachably connected to the central housing part in view of Adams so that it will be easy to assembly/disassembly for maintenance.

Allowable Subject Matter

16. Claims 51-60, 63-66, 68-71, 74-75, 77-83, 86-91 and 97-98 are allowed.

17. Claims 61, 62, 67, 72, 73, 76, 84, 85 and 92-96 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Cited Prior Art

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see the attached form PTO-892).

Communication

19. Submission of your response by facsimile transmission is encouraged. The fax phone numbers for the organization where this application or proceeding is assigned are **(571) 273-8300**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P.. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to
the Patent and Trademark Office on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P.. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ha D. Ho whose telephone number is **571-272-7091**. If attempts

to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on **571-272-7095**.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/HDH/
(571) 272-7091
February 9, 2009

/Ha D. Ho/
Primary Examiner, A.U. 3655